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14 **UNITED STATES DISTRICT COURT**
15 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
16 **SAN JOSE DIVISION**
17

18 REGENTS OF THE UNIVERSITY OF
MINNESOTA,

19 Plaintiff,

20 v.

21 LSI CORPORATION AND
22 AVAGO TECHNOLOGIES U.S. INC.,

23 Defendants.
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28

Civil Action No. 18-cv-00821-EJD-NMC

**DEFENDANTS' REPLY IN SUPPORT OF
MOTION TO STAY THE ACTION
PENDING *INTER PARTES* REVIEW**

Date: May 31, 2018

Time: 9:00 A.M.

Place: Courtroom 4 – 5th Floor

Hon. Edward J. Davila

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I. INTRODUCTION

Plaintiff Regents of the University of Minnesota (the “University”) argues that LSI’s Motion to Stay¹ “should be denied for *three* reasons.” (Plaintiff’s Memorandum of Law In Opposition to Motion to Stay, Dkt. 202 (“Opposition”) at 1 (emphasis in original).) Examination of each of the three reasons reveals that none has merit and that the Motion to Stay should be granted.

First, while it is true that “PTAB has not yet even reviewed the merits of Defendants’ IPR” (Opposition at 1), this is due entirely to conduct of the University. LSI filed its IPR petition challenging the patentability of the ’601 Patent more than a year ago. In response, the University first raised an Eleventh Amendment defense to stave off the PTAB’s review. When that defense was rejected, the University appealed and invoked the obscure “collateral order doctrine” in order to “divest” the PTAB of jurisdiction pending the appeal. (*See* Dkt. 191 at 4-6.) The ’610 patent IPR now is effectively stayed and the Eleventh Amendment defense awaits briefing in the Federal Circuit. But for the University’s actions, the IPR would have been nearing completion by now, because the Petition was filed on March 10, 2017, and IPRs last one year from the date of institution. 35 U.S.C. § 316(a)(11). In any event, as reflected in the many cases cited in LSI’s moving brief, there is abundant case law in this District that a stay may be appropriate even if a pending IPR petition has not triggered an affirmative institution decision.

Second, the University’s unspecified and unsupported concern about “loss of witness memory and documents” rings hollow and should be rejected. The term of a patent is twenty years, yet the University brought suit against LSI when the ’601 Patent was six weeks from expiration. The named inventors have long since scattered to the wind (*e.g.*, one now lives in Korea, outside the subpoena power of any U.S. court) and the University has few documents relating to their work. Given this scenario, the University should not be heard to complain about loss of memory or loss of documents. For its part, LSI already has produced all documentation that the University needs to make its case and document retention holds are in place so that all

¹ Defendants LSI Corporation and Avago Technologies U.S. Inc. are collectively referred to herein as “LSI.”

relevant documents in existence and available now, will be available later. The parties have also stipulated that any documents created after the patent expired (*i.e.*, after October 15, 2016) do not need to be produced. Hence, in addition to the fact that the University has not backed up this claimed concern with a declaration or specific facts, the reality is that having waited nearly twenty years to file suit, the University has no legitimate basis to claim that the passage of another year or even two would materially impact witness memory or the availability of relevant documents.

Third, the case was at its earliest possible stage when LSI first filed this motion to stay in July 2017 (before the case was transferred to this District), and the case remains at an early stage. The parties are engaged in the claim construction process and not a single deposition has been conducted. The standard is whether discovery is “complete” and whether a trial date has been “set.” *Pragmatus AV, LLC v. Facebook, Inc.*, No. 11-CV-02168-EJD, 2011 WL 4802958, at *2 (N.D. Cal. Oct. 11, 2011). Here, discovery is *not* complete and a trial date has *not* been set.

In light of the relevant factors as discussed in LSI’s moving brief and below, and given the lack of a contrary showing by the University, this complex patent case should be stayed before the Court expends significant effort in the claim construction process and the parties begin costly fact discovery.

II. ARGUMENT

A. Defendants Have Not “Delayed” The Case.

In an unfortunate effort to muddy the waters and sully LSI, the University goes on for pages accusing Defendants of delay tactics. (Opposition at 2-5.) The University’s accusations are baseless.

First, LSI timely moved to dismiss under Fed. R. Civ. P. 12(b)(6) at the outset of the case. There was nothing improper or nefarious about the motion. Instead of opposing the motion, the University voluntarily amended its Complaint, fixing some of its defects. (*See* Dkt. 41 at 1 (“As a result of the University having filed its First Amended Complaint, Defendants’ Motion is moot.”).)

Defects remained in the Amended Complaint. So LSI timely renewed its motion. While the Court ultimately denied the motion, nothing in the Court’s opinion even remotely suggests that

LSI's motion was filed for an improper purpose. To the contrary, the Court rejected as a matter of law two of the alleged factual bases for the University's allegation that LSI had "pre-suit notice" of its alleged infringement.² Notice is an element of (i) induced infringement, (ii) contributory infringement, and (iii) willful infringement. Thus, even though the motion was denied, the University will be gravely challenged to prove its inducement, contributory, and willfulness claims in light of the Court's findings. As for the University's accusation of "a strategy of delay," it is not LSI's fault that the District of Minnesota decided the motion almost a year after the Complaint was filed.

Second, in light of an intervening change in the law by the Supreme Court relating to the patent venue statute,³ LSI moved to dismiss under Fed. R. Civ. P. 12(b)(3) for improper venue. (Dkt. 191 at 7.) It is difficult to understand how the University can assert that the motion was an improper "delay tactic[]" because the District of Minnesota *granted* it, finding that "Minnesota is not a proper venue." (Dkt. 144 at 9.) If the University was concerned with a speedy resolution of this case, it could have stipulated to a transfer of venue to this District, which was clearly the only proper venue. Instead, the University litigated venue, for months. In the end, District of Minnesota Judge Wright found that University's venue argument was based "entirely on speculation and innuendo" and ordered transfer to this District. (*Id.* at 8.) If the over eight-month process of litigating venue and resetting the case after the transfer counts as "delay," it is the fault of the University, not of LSI.⁴

Third, the University's fusillade of allegations regarding Defendants' discovery efforts (Opposition at 4) lack merit and have no relevance to the issue of staying this case. Tellingly, the

² See Dkt. 56 at 10 ("[An academic paper published in 1996 by the inventors] could not have provided notice that the innovation described therein was patented."); *id.* ("The First Amended Complaint states that a patent examiner cited the '601 Patent during the examination of two unrelated LSI patents. That fact does not established Defendants' knowledge of the '601 Patent.").

³ See *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S.Ct. 1514 (2017).

⁴ Counsel met and conferred on July 25, 2017, but the University did not agree that the case should be transferred. See Dkt. 69. The District of Minnesota transferred the case on February 1, 2018, see Dkt. 144; the case was reassigned to Judge Davila on February 12, 2018, see Dkt. 150; Judge Davila issued the Patent Scheduling Order on March 14, 2018, see Dkt. 186; LSI renewed the Motion to Stay two days later, on March 16, 2018, see Dkt. 191.

University has not taken up any of its grievances with the Magistrate Judge other than a discrete dispute between the parties about the scope of damages discovery.⁵ The University's harsh accusations of a "strategy of delay," "gamesmanship," and a plot "to postpone the day of reckoning" (Opposition at 3, 13, and 4, respectively), are belied by the facts. Indeed, the vast majority of the "delays" in this matter arise from the failure of the University to act or flow from the time-cycle of busy U.S. District Courts.

B. The University Should Not Benefit From Its Derailing of the IPR Proceedings.

The University's primary argument against a stay is that its immediate appeal of the PTAB's denial of the University's motion to dismiss the IPR could take "years." (Opposition at 5-7.) In a rehash of same arguments that the PTAB rejected, the University predicts that the Federal Circuit will reverse the PTAB's unanimous decision. This would supposedly result in a delay of these proceedings "without any simplification of the issues in this case." (*See id.*)

The University's optimistic prediction is not warranted. The University's sovereign immunity appeal presents an issue of first impression, so that neither party can say decisively what outcome the law dictates. Nevertheless, there is good reason to believe that the Federal Circuit will find that the Eleventh Amendment does not apply in IPRs in light of the Supreme Court's intervening opinion in *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, No. 16-712, --- S.Ct. ---, 2018 WL 1914662 (Apr. 24, 2018). In *Oil States*, the Court ruled that an IPR does not affect a patent owner's "private rights" because "the decision to *grant* a patent is a matter involving public rights" and "[i]nter partes review is simply a reconsideration of that grant." *Oil States*, 2018 WL 1914662, at *6. Thus, from a constitutional perspective, IPRs and original

⁵ Contrary to the University's narrative, Magistrate Judge Rau of the District of Minnesota *did* grant Defendants' motion for a protective order, after the University jumped the gun by serving burdensome discovery requests before the Court scheduled an initial Case Management Conference. Magistrate Judge Rau did so orally in chambers, telling the Defendants that they did not have to respond to the University's initial discovery requests dated August 25, 2017. The University then unilaterally waited an entire month -- until October 26, 2017 -- to serve its "amended" discovery requests. Defendants timely responded and have, to date, produced thousands of documents comprising about 200,000 pages and have also made their source code available for inspection.

1 prosecution before the USPTO are on equal footing, neither implicates a private right nor triggers
 2 the immunity afforded by the Eleventh Amendment.⁶

3 Now that the Supreme Court has spoken in *Oil States*, the most likely outcome of the
 4 University's appeal is that it will be affirmed without the Federal Circuit reaching the issue of the
 5 University's waiver of its immunity through its litigation conduct. However, if the Federal Circuit
 6 finds that the Eleventh Amendment applies in IPRs, the PTAB's decision should still be affirmed
 7 because the University waived its immunity when it sued LSI in federal court. (*See* Dkt. 191-2
 8 (PTAB's denial of University's motion to dismiss IPR).) The University suggests that
 9 "precedent" prevents the waiver of immunity in IPR by the filing of an infringement case. Not so:
 10 there is no "bright-line rule whereby a State's waiver of sovereign immunity can never extend to a
 11 ... separate lawsuit." *Biomedical Patent Mgmt. Corp. v. Cal., Dep't of Health Services*, 505 F.3d
 12 1328, 1339 (Fed. Cir. 2007). Indeed, the University's current argument contradicts arguments it
 13 made in an earlier, different IPR proceeding. It told the PTAB previously that "[b]y voluntarily
 14 invoking federal jurisdiction in the infringement litigation, the [S]tate entity could be deemed to
 15 have waived its sovereign immunity to the IPR process[.]" (Dkt. 191-2 at 8-9.) The University
 16 was right then: a state waives immunity to foreseeable claims that a defendant must file in
 17 response to the state's complaint "or be forever barred from doing so." *Regents of Univ. of New*
 18 *Mexico v. Knight*, 321 F.3d 1111, 1125-26 (Fed. Cir. 2003). The University anticipated that LSI
 19 would file an IPR after being sued. In fact, Defendants had to file their IPR Petition within one

20 _____
 21 ⁶ In certain respects, the Supreme Court's reasoning in *Oil States* is remarkably similar to the
 22 concurring PTAB judge's prescient opinion in the decision denying the University's motion to
 dismiss LSI's IPR Petition based on a claim of sovereign immunity:

23 The essential nature of *inter partes* review as a reevaluation by the Patent Office
 24 of its decision to grant a patent, rather than as an administrative analog to civil
 25 litigation, is evident from the relief available, which differs both in degree and in
 26 kind from that afforded in federal district court. At its core, *inter partes* review is
 27 a circumscribed *in rem* proceeding, in which the Patent Office exercises
 jurisdiction over the patent challenged, rather than the parties named; "it does not
 implicate States' sovereignty to nearly the same degree as other kinds of
 jurisdiction." *Cent. Va. Cmty. Coll. v. Katz*, 546 U.S. 356, 362 (2006).

28 (Dkt. 191-2, concurring op. at 3.)

1 year of service of the Complaint. *See* 35 U.S.C. § 315(b). Thus, as the PTAB panel found, “it is
 2 reasonable to view a State that files a patent infringement action as having consented to an *inter*
 3 *partes* review of the asserted patent.” (Dkt. 191-2 at 7.)

4 **C. Case Law Supports the Rationale Behind a Stay.**

5 The University suggests that “courts in this District routinely deny stay requests like that of
 6 Defendants.” (Opposition at 9.) But none of the cases it cites is anything “like” this one; here the
 7 IPR has not advanced due to the University’s own procedural moves. More persuasive are the
 8 many cases where judges in this District have granted stays pending IPR or reexamination
 9 proceedings *before* the Patent Office instituted such proceedings. *See, e.g., Pragmatus AV, LLC v.*
 10 *Facebook, Inc.*, No. 11-CV-02168-EJD, 2011 WL 4802958, at *3 (N.D. Cal. Oct. 11, 2011)
 11 (“Indeed, it is not uncommon for this court to grant stays pending reexamination prior to the PTO
 12 deciding to reexamine the patent.”); *see also* Moving Brief (Dkt. 191) at 10.

13 LSI is aware of only a handful of times where a university asserted a patent in federal court
 14 and then resisted an IPR on the basis of sovereign immunity. In each case, the university is the
 15 University of Minnesota. *All* of its other cases have been stayed pending IPR. The District of
 16 Minnesota stayed multiple cases against AT&T and other wireless carriers, and Judge Chhabria
 17 stayed the University’s case against Gilead. (*See* Dkt. 191 at 6.) Those cases were at more
 18 advanced stages of litigation than this one, and involved patents that were *not* expired. The
 19 University vigorously opposed the motions to stay in those cases, making all of the same
 20 arguments it makes now. This Court should follow the lead of Judge Chhabria and the District of
 21 Minnesota, and stay this case until final resolution of the IPR involving the expired patent.

22 **D. The University Will Not Be Unduly Prejudiced or Disadvantaged By A Stay.**

23 Lack of prejudice to the non-movant is the most important factor in deciding whether to
 24 grant a stay. The University’s arguments on this factor lack merit, as shown below.

25 **1. The Expiration of the ’601 Patent Weighs in Favor of a Stay.**

26 The University barely discusses the fact that the term of its patent has expired, summarily
 27 concluding that this fact is “of no moment.” (Opposition at 3.) But all authority is to the contrary.
 28

1 First, when a patent expires, “the monopoly created by it expires too, and the right to make
2 the article ... passes to the public.” *Sears, Roebuck & Co., v. Stiffel Co.*, 376 U.S. 225, 230
3 (1964). Thus, a stay of litigation involving an expired patent will not result in undue prejudice to
4 the patent owner. *See Sorensen v. Lexar Media, Inc.*, No. C:08-00095-JW, 2009 WL 10695750,
5 *2 (N.D. Cal. February 25, 2009) (“[G]iven that the ’184 patent has otherwise expired, Plaintiff’s
6 remedies will be limited to damages already incurred from any alleged infringement. ... Thus, the
7 Court cannot ascertain any prejudice that will inure to Plaintiff as the result of a stay[.]”).⁷

8 Second, even when a patent is *not* expired, a stay pending Patent Office proceedings will
9 not unduly prejudice a patent owner who has not moved for a preliminary injunction. *See Blacoh*
10 *Fluid Controls, Inc. v. Syrinix, Inc.*, Case No. 17-cv-04007-NC, 2018 WL 1000688, *3 (N.D. Cal.
11 February 21, 2018) (“Also, the fact that Blacoh failed to request a preliminary injunction weighs
12 against its argument of undue prejudice.”).⁸ The University never has sought preliminary
13 injunctive relief. It cannot receive a permanent injunction either, as the patent is expired.

14 Third, denial of the Motion has the potential to prejudice *Defendants*, who would have to
15 defend themselves in litigation even though the Patent Office might extinguish the University’s
16 patent rights. *Sorensen*, 2009 WL 10695750, at *2.

17 Fourth, the potential for streamlining this case is greater because the University cannot
18 “amend” its expired patent claims to avoid the invalidity challenges at issue in the IPR
19 proceedings. *See MLC Intellectual Property, LLC*, 2017 WL 4948560, *2-*3.

20
21 ⁷ *See also Sorensen v. Lexar Media, Inc.*, No. C:08-00095-JW, 2010 WL 11538250, *1 (N.D. Cal.
22 October 27, 2010) (denying motion to lift stay while reexamination decision was on appeal, finding
23 no prejudice because the patent “has expired and damages are not accruing”); *MLC Intellectual*
24 *Property, LLC v. Micron Technology, Inc.*, Case No. 14-cv-03657-SI, 2017 WL 4948560, *2-*3
25 (N.D. Cal. November 1, 2017) (“The facts that the ’571 patent is expired and that MLC is a non-
26 practicing entity also support a stay, as MLC does not allege any current or future harm. ... [T]he
27 Court notes that some courts have found that the likelihood for cancellation of one or more of the
28 claims may be increased due to the fact that the [patent] is expired and not subject to amendment in
the ex parte reexamination proceedings.”) (internal citation omitted); *Lam Research Corporation v.*
Flamm, Case No. 15-cv-01277-BLF, 2016 WL 4180412, *4 (N.D. Cal August 8, 2016) (staying
case where parties were not competitors and patents had expired).

⁸ *See also LifeScan, Inc. v. Shasta Technologies, LLC*, No. 5:11-cv-04494-EJD, 2013 WL 1149819,
*3 (N.D. Cal. March 19, 2013) (granting stay as to two patents that were not the subject of a
preliminary injunction, even though reexamination “can take more than two years to complete”).

2. **The University's Delay in Filing Suit Weighs In Favor of a Stay.**

The University alleges that LSI has infringed for years and refused to take a license. (Opposition at 3.) This is fiction. The University approached LSI about licensing patents generally in 2013, LSI responded, and then the University went radio-silent for three years before dropping this suit on LSI in August 2016, without prior notice. The University's delay in asserting its purported patent rights for the first time only weeks before expiration undercuts any argument that a stay would result in undue prejudice. *See VirtualAgility, Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1319 (Fed. Cir. 2014) ("[F]or some unexplained reason, waited nearly a year after the '413 patent issued before it filed suit against Defendants. These facts weigh against VA's claims that it will be unduly prejudiced by a stay.").

3. **Other Courts Have Rejected the University's Arguments.**

The University tries, but fails, to distinguish the decisions of the District of Minnesota and of this Court staying the University's other cases pending IPR proceedings. For example, the University cites three points that supposedly distinguish the District of Minnesota wireless carrier cases from this case, but none of the points of distinction carry any discernable weight. (*See* Opposition at 11-12.) The University attempts to distinguish Judge Chhabria's stay in this District on the basis that Gilead had entered into a "stipulation" that could result in "simplification of issues." (*Id.* at 12-13.) But after Judge Chhabria stayed the case, the University moved for reconsideration (which was denied), arguing that "Gilead's stipulation" was "unlikely to meaningfully simplify issues for trial." (Case 3:17-cv-06056-VC, *see* Dkt. 310 at 1.) Accordingly, the University's attempt to distinguish Judge Chhabria's decision fails, as does the University's proposal that Defendants enter into an elaboration stipulation as a condition for securing a stay pending IPR in this case. Contrary to the University's suggestion, LSI cannot raise "countless" invalidity defenses because invalidity contentions are governed by the Local Patent Rules and IPR-based estoppel is specifically addressed in the Patent Act. *See* 35 U.S.C. § 315(e)(2). Ultimately, there is no justification for treating this case differently than the other University cases with parallel IPR proceedings – all of which have been stayed.

4. **There Was No “Gamesmanship” in Seeking IPR and a Stay.**

The University alleges that “the timing” of Defendants’ IPR Petition and subsequent motion to stay “suggest that Defendants seek a tactical advantage through this Motion.” (Opposition at 13.) Not so. Preparing an IPR Petition is a substantial undertaking that requires thorough prior art searching and careful selection of which references to assert and which claims to challenge. The ’601 Patent, which contains complicated subject matter, inspired an IPR Petition more than 70 pages in length involving four separate grounds and a 79 page expert declaration. By statute, LSI had one year from the service of the Complaint to file the Petition for IPR. 35 U.S.C. § 315(b). LSI filed its Petition five months before that deadline. LSI then moved to stay on July 26, 2017, before any litigation on the merits, and long before discovery opened. In fact, LSI filed its IPR Petition *before* the University served its infringement contentions, reflecting LSI’s desire to expedite the process. Hence, far from tactically delaying matters, LSI filed its IPR Petition *early*, before knowing which claims are at issue and well before the statutory deadline.

5. **Any Risk of “Fading Memories” and “Loss of Documentation” is Outweighed By the Benefits of a Stay.**

The generalized prospect of “fading memories” and “loss of documentation” does not constitute undue prejudice. Otherwise, no motion to stay would ever be granted. Indeed, this Court has stayed litigation pending *ex parte* reexamination proceedings, even though such proceedings are far lengthier than IPR proceedings, and can take years to complete. *See, e.g., LifeScan*, 2013 WL 1149819, *3 (granting stay over plaintiff’s objection that reexamination “can take more than two years to complete”).

In any event, the University offers no declarations or other form of evidence backing up its cursory arguments about the purely hypothetical loss of memories or documentation. (*See* Opposition at 13-14.) The University’s patent is now 22 years old. If evidence is going to be lost, it has happened already. Further, LSI already has supplied all of the documentation that the University needs to attempt to make its case. This documentation includes, among other things, the voluminous product specifications for the accused products (each of which run thousands of pages long) and thousands upon thousands of lines of source code for the accused products. And

1 if the University were legitimately concerned with “fading memories,” it could have taken some
 2 depositions. To date, it has taken zero. Likewise, the University has not issued subpoenas to any
 3 of LSI’s customers or former employees. If the University can wait 22 years to seek documents
 4 and testimony, it can wait a while longer until the IPR process is finalized.

5 **E. The IPR Proceedings Could Simplify or Moot This Case.**

6 The University’s argument that the IPR will not simplify any issues for trial is premised on
 7 the University’s naked assertions that the Federal Circuit will reverse the PTAB’s denial of the
 8 University’s immunity defense and that the PTAB would not institute IPR even if the University
 9 loses its appeal. (*See* Opposition at 8-11, 14-15.) Both assertions are obviously speculation and
 10 both lack merit.

11 First, as discussed above, the University should not benefit in this forum from its derailing
 12 of the IPR process. The IPR would be substantially completed by now but for the University’s
 13 assertion of sovereign immunity (via a motion to dismiss) and its appeal of the PTAB’s rejection
 14 of that motion. No doubt the University would point out its right to assert sovereign immunity to
 15 stop the IPR process; at the same time, however, the University should recognize LSI’s right to
 16 have that immunity claim adjudicated before being forced to defend a parallel, expensive,
 17 disruptive District Court litigation.

18 Second, assuming the University loses the appeal, the PTAB will either institute the IPR,
 19 or it will deny institution. Institution is likely because LSI has identified multiple instances of
 20 prior art that disclose each and every limitation of the challenged patent claims, exactly. But the
 21 case will be simplified *either way*. At a minimum, the IPR will likely shed light on the meaning of
 22 the claims, may give rise to estoppel of arguments, claims or defenses, and could prompt a
 23 settlement. *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1362 (Fed. Cir. 2017) (“[W]e hold
 24 that statements made by a patent owner during an IPR proceeding, *whether before or after an*
 25 *institution decision*, can be considered for claim construction and relied upon to support a finding
 26 of prosecution disclaimer.”) (emphasis added); *see also Microsoft Corp. V. Tivo Inc.*, No. 10:cv-
 27 00240-LHK, 2011 WL 1748428 (N.D. Cal. May 6, 2011), at *4. When the District of Minnesota
 28 stayed the University’s cases against wireless carriers, it held that “the potential for enormous cost

1 and time savings should an IPR result outweighs the delay caused by a stay ... Even the chance
 2 for simplification in these hyper complex cases warrants the measure of instituting a stay before
 3 IPR has instituted.” (Dkt. No. 87-1, at *20-*21.) So too here.

4 For all of these reasons, this second factor of simplification also favors a stay.

5 **F. Discovery is Not Complete and No Trial Date has Been Set.**

6 Defendants initially moved to stay before either Defendant had answered. The District of
 7 Minnesota did not decide that original stay motion because venue was improper and the case was
 8 transferred to this District. Two days after this Court issued its Patent Scheduling Order on March
 9 16, 2018, Defendants re-noticed the Motion here. At that time, there were still six months left in
 10 discovery, and no trial date had been set.

11 Whether one looks at the date of the original motion, or the date of the re-noticed motion,
 12 the case was at an early stage. The University points out that the parties have done things like
 13 exchange contentions and preliminary claim constructions. (Opposition at 15.) But these things
 14 happen early under the Local Patent Rules. Defendants concede, as they must, that neither party
 15 has taken a deposition and that claim construction briefing has not yet started. (*See id.*)

16 For all of these reasons, this third factor also favors a stay.

17 **G. A Stay Will Reduce the Burdens of Litigation on the Court and Parties.**

18 Litigating overlapping issues of patent validity in different forums is hardly an efficient use
 19 of this Court’s or the parties’ resources, especially because the patent is expired and the PTAB
 20 already has rejected the University’s sovereign immunity defense. The University has no direct
 21 response to these issues. (*See* Opposition at 7 n.4.) As such, this fourth factor also favors a stay.

22 **III. CONCLUSION**

23 For the reasons stated above and in LSI’s Moving Brief, LSI respectfully requests that the
 24 Court stay this litigation pending the IPR involving the expired ’601 Patent.

1 DATED: April 27, 2018

Respectfully submitted,

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